

REMARKS

In this Office Action, the Examiner objected to Claims 1, 3 – 5, 9 – 11, 13, 15, 16 19 – 21, 23 and 25. Claims 1, 6, 11, 16, 21 and 26 were rejected under 35 U.S.C. §112, second paragraph, for indefiniteness. Claims 1 – 30 were rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. Claims 1, 9, 11 and 19 were rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over Claims 1, 3, 4 and 6 of US Patent 6,823,368. Claims 1 and 3 were rejected under 35 U.S.C. §102(b) as being anticipated by Hara. Claims 1 – 3, 5, 6, 11 – 13, 15, 16, 21 – 23, 25 and 26 were rejected under 35 U.S.C. §102(b) as being anticipated by Birrell et al. Claims 1 – 4, 7 – 14, 17 – 24 and 27 – 30 were rejected under 35 U.S.C. §102(e) as being anticipated by Ullmann et al.

Claims 1, 3 – 5, 9 – 11, 13, 15, 16 19 – 21, 23 and 25 have been amended to overcome the objection made thereto. Claims 1, 6, 11, 16, 21 and 26 were also amended to overcome the §112 rejection made thereto. The independent claims (i.e., Claims 1, 11 and 21) were further amended to overcome the 101 rejection made thereto. Specifically the independent claims were redirected from “selecting recipients of an e-mail message” to “sending an e-mail message to recipients” and the last element of the claims was changed to include the step of “sending the e-mail message to the recipients”. Applicants believe these amendments have successfully overcome the objection, 112 and 101 rejections made to the claims and respectfully request their withdrawal.

Regarding the unpatentability of Claims 1, 9, 11 and 19 on the ground of non-statutory obviousness-type double patenting over Claims 1, 3, 4 and 6 of US Patent 6,823,368, Applicants believe that it was unwarranted. Claims 1, 3, 4 and 6 of US Patent 6,823,368 include the limitations of “managing chain sender addresses”. That is, the claims are directed toward being able to manage e-mail

addresses of users who have sent one or more previous e-mail messages that are part of a body of a present e-mail message.

By contrast as originally drafted, Claims 1, 9, 11 and 19 in the present Application were directed toward selecting e-mail addresses of users to which an e-mail message is to be sent from a list of e-mail addresses of everyone in a chain of e-mail messages that make up a present e-mail message including recipients as well as senders of the messages in the chain. As such, the claims should not have been rejected on the ground of non-statutory obviousness-type double patenting over Claims 1, 3, 4 and 6 of US Patent 6,823,368.

Nonetheless, please note that the claims are amended (1) to make specific that the list of e-mail addresses is made up of recipients as well as senders of e-mail messages in a chain of e-mail messages that makes up a present e-mail message and (2) the message is to be sent to users of selected e-mail addresses as opposed to managing e-mail addresses.

By this amendment, Claims 1 – 30 remain pending in the Application. For the reasons stated more fully below, Applicants submit that the pending claims are allowable over the applied references. Hence, reconsideration, allowance and passage to issue are respectfully requested.

As disclosed in the SPECIFICATION, sometimes an e-mail message from sender A is intended for recipient B but is sent to a general mailbox address C which then forwards it to B, or to an address C which screens B's e-mail and then forwards it to B. B may compose a reply intended for A and inadvertently automatically replies to C rather than A. Similarly there may be a lengthy series of e-mail exchanges, one of which originated with A, and the latest of which is received by Z from Y. Z may wish to reply to A but to do so requires backtracking through the lengthy history to find and manually enter A's address, or he/she may inadvertently reply automatically to Y with a message intended for A. Thus, there is a need for a method for permitting recipients of a multi-party e-

mail message to easily select users that are to receive a reply to an e-mail message. The present invention provides such method.

According to the teachings of the present invention, when sending an e-mail message to a plurality of users in response to a received e-mail message that includes a chain of previously sent e-mail messages wherein each previously sent e-mail message includes at least one previous sender and one previous recipient, an e-mail recipient may select one or more of the e-mail addresses of the users from a list. The list is made by parsing the received e-mail message for e-mail addresses of the previous senders and recipients and displayed to the e-mail recipient. After selecting the addresses of the users, the e-mail recipient may send the e-mail message to the users.

The invention is set forth in claims of varying scopes of which Claim 1 is illustrative.

1. A method of sending an e-mail message to a plurality of users by an e-mail recipient in response to a received e-mail message, the received e-mail message including a chain of previously sent e-mail messages wherein each previously sent e-mail message includes at least one previous sender and one previous recipient, the method comprising:

parsing the received e-mail message for e-mail addresses of the previous senders and recipients to form a list of e-mail addresses;

displaying said list of e-mail addresses;

selecting, by the e-mail recipient, one or more of the e-mail addresses from the list to address the e-mail message, each selected e-mail address identifying a user to which the e-mail message is to be sent; and

sending the e-mail message to the users identified by the selected addresses. (Emphasis added.)

The Examiner rejected the claims under 35 U.S.C. §102(b) as being anticipated by Hara, Birrell et al. and Ullmann et al. Applicants respectfully disagree.

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Hara purports to teach a method for determining destination addresses of e-mail messages from stored e-mail messages. Accordingly, Hara teaches that received e-mail messages are stored in a storage apparatus, and when a key word is inputted from an input apparatus, an electronic mail containing this key word is retrieved from this storage apparatus. Then, a mail address contained in the electronic mail retrieved by a retrieving unit is extracted as a mail address of a transmission destination candidate. The extracted mail address of the transmission destination candidate is outputted to an output apparatus, and a user selects as a transmission destination the mail address.

The extracted mail addresses, however, are mail addresses of the current sender and recipients of the e-mail message (see col. 7, lines 38 to 58 of Hara). It does not include mail addresses of previous e-mail messages that make up the current e-mail message.

Therefore, Hara does not teach, show or suggest the step of ***parsing the received e-mail message*** (that contains a chain of previous e-mail messages) ***for e-mail addresses of previous senders and recipients to form a list of e-mail addresses*** as claimed.

Birrell et al. purport to teach a technique for dynamically generating an address book in a distributed electronic mail system. Mail messages are stored in message files of a mail service system. The mail messages are parsed and indexed to generate a full-text index of the mail service system. Address book mail messages are generated, each address book mail message includes address information. The address book mail messages are stored in the message files. The address book mail messages are also parsed and indexed into the full-text index file. A query is composed using a particular one of the plurality of client computer systems to search the full-text index to locate and retrieve selected ones of the address book mail messages as the dynamic address book. The address information can be generated using a form supplied by client mail application programs executing on the particular client computer.

The client mail application programs are down-loaded to the particular client computer via the network.

However, just as in the case of Hara, Birrell et al. do not teach, show or suggest the step of ***parsing a received e-mail message*** (that contains a chain of previous e-mail messages) ***for e-mail addresses of previous senders and recipients to form a list of e-mail addresses*** as claimed.

Ullmann et al. teach a method for e-mail chain group. Accordingly, Ullmann et al. teach an enhanced e-mail reader and composer having automatic addressing functions to create and manage chain groups for organizing chain-forwarded and chain-replied messages. The e-mail reader and composer allows users to receive chained messages, automatically create chain groups within their address book, associate chain message participants to chain groups, and to automatically address new messages to members of chain groups stored within their address book.

However, Ullmann et al. do not teach the step of ***parsing a received e-mail message*** (that contains a chain of previous e-mail messages) ***for e-mail addresses of previous senders and recipients to form a list of e-mail addresses*** as claimed.

Consequently, Applicants submit that the Claim 1, as well as its dependent claims, is allowable over each one of the applied references. The other independent claims (i.e., Claims 11 and 21) and their dependent claims, which all incorporate the emboldened-italicized limitations of the above-reproduced Claim 1, are also allowable. Hence, Applicants once more respectfully request reconsideration, allowance and passage to issue of the claims in the application.

Respectfully Submitted

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